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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,562	04/09/2004	Kevin E. Collier	14794.3.1.1	1275

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EXAMINER

REIFSNYDER, DAVID A

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,562

Applicant(s)

COLLIER, KEVIN E.

Examiner

David A. Reifsnnyder

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/05; 8/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 claims "wherein one of the first tube and the second tube is disposed within the other"; however, the specification fails to teach a tube within a tube extending from the rotational axis toward the peripheral wall.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 4 claims "wherein the first tube and the second tube are integrally formed"; however, the specification fails to teach integrally formed tubes extending from the rotational axis toward the peripheral wall.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not

Art Unit: 1723

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 claims "wherein the first tube is aligned with or offset from the rotational axis" however, the specification fails to teach a tube aligned with and extending from the rotational axis toward the peripheral wall.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 26 claims "wherein one of the first tube and the second tube is disposed within the other"; however, the specification fails to teach a tube within a tube extending from the tubular member toward the peripheral wall.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 28 claims "wherein the first tube and the second tube are integrally formed"; however, the specification fails to teach integrally formed tubes extending from the tubular member toward the peripheral wall.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

Art Unit: 1723

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 29 claims "wherein the first tube is aligned with or offset from the rotational axis"

however, the specification fails to teach a tube aligned with and extending from the tubular member toward the peripheral wall.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5; since claim 1 claims that the "first tube extends from the rotational axis toward the peripheral wall" the recitation in claim 5 of "wherein the first tube is aligned with or offset from the rotational axis" is vague and indefinite as to how the first tube can be extend from the rotational axis to the peripheral wall and also be aligned with the rotational axis.

Regarding claim 29; since claim 23 claims that the "first tube extends from the tubular member toward the peripheral wall" the recitation in claim 29 of "wherein the first tube is aligned with or offset from the rotational axis" is vague and indefinite as to how the first tube can be extend from the tubular member to the peripheral wall and also be aligned with the rotational axis.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-9 and 23-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5, 7-9 and 23-32 claim a separator having all of the features of claim 1 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claim 6 is a rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 claims a separator having all of the features of claim 9 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that

Art Unit: 1723

it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 10 and 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 10 and 33 claim a separator having all of the features of claim 2 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 11 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11 and 34 claim a separator having all of the features of claim 3 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 12 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12 and 35 claim a separator having all of the features of claim 4 of U.S. Patent No. 6,346,069 B1 except for an exit tube.

Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 13 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13 and 36 claim a separator having all of the features of claim 6 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 14 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14 and 37 claim a separator having all of the features of claim 7 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 15 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 15 and 38 claim a separator having all of the features of claim 10 of U.S. Patent No. 6,346,069 B1 except for an exit tube.

Art Unit: 1723

Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 16 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 16 and 39 claim a separator having all of the features of claim 11 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 17 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim (12 or 13) of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 17 and 40 claim a separator having all of the features of claim (12 or 13) of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 18 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 18 and 41 claim a separator having all of the features of claim 16 of U.S. Patent No. 6,346,069 B1 except for an exit tube.

Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 19 and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 19 and 42 claim a separator having all of the features of claim 17 of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Claims 20-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-20, respectively of U.S. Patent No. 6,346,069 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-22 claim a separator having all of the features of claims 18-20, respectively of U.S. Patent No. 6,346,069 B1 except for an exit tube. Furthermore, it is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention that a separator have an exit tube.

Allowable Subject Matter

Claims 1-42 would be allowable over the prior art of record if claims 2, 4, 5, 26, 28 and 29 are amended to overcome the above 35 USC 112 rejections and a terminal disclaimer is submitted to overcome the above double patenting rejection.

Art Unit: 1723

The main reason for the allowance of claims 1-22 over art (i.e. except for the above double patenting rejection) is the instantly claimed separator comprising: a vessel having a peripheral wall bounding a chamber, the vessel being rotatable about a rotational axis extending through the vessel, the chamber communicating with an inlet and a first outlet; a plurality of fins disposed within the chamber; a second tube extending from toward the rotational axis to toward the peripheral wall, the second tube having a first end in fluid communication with the exterior of the vessel and an opposing second end bounding a second outlet, **the first outlet being disposed closer to the rotational axis than the second outlet such that during use a fluid boundary line can be formed between the first outlet and the second outlet;** and a first tube extending from toward the rotational axis to toward the peripheral wall, the first tube being coupled with a fluid source for selectively dispensing a fluid stream at or adjacent to the peripheral wall.

The main reason for the allowance of claims 23-42 over art (i.e. except for the above double patenting rejection) is the instantly claimed separator comprising: a vessel having a peripheral wall bounding a chamber, the vessel being rotatable about a rotational axis extending through the vessel, the chamber communicating with an inlet and a first outlet; a tubular member disposed within the chamber and communicating external thereof; a plurality of fins disposed within the chamber, each of the fins extending from toward the tubular member to toward the peripheral wall; and a first tube projecting from the tubular member to toward the peripheral wall, the first tube having a second outlet in communication with the chamber, **the first outlet being**

Art Unit: 1723

disposed closer to the rotational axis than the second outlet such that during use a fluid boundary line can be formed between the first outlet and the second outlet.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Reifsnyder whose telephone number is (571) 272-1145. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda M. Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David A Reifsnyder
Primary Examiner
Art Unit 1723

DAR